

14303 (0901.68198)

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Richard J. Ernst  
Serial No.: 10/687,451  
Conf. No.: 8743  
Filed: October 16, 2003  
For: ROD HANGER FOR SECURING A  
ROD TO A SUBSTRATE  
Art Unit: 3632  
Examiner: Epps, Todd Michael

APPELLANTS' REPLY BRIEF ON APPEAL UNDER 37 C.F.R. §41.41

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is filed in response to the Examiners' Answer dated February 19, 2010.

## **REPLY BRIEF**

As explained in the Appeal Brief, issues on appeal include:

- I. Whether the resilient washer disclosed by the ‘185 patent can support the obviousness rejections of claims 32, 35, 36 and 38.**
- II. Whether the sharp pointed gripper prongs of the ‘723 patent can properly support a rejection of claim 37.**
- III. Whether Claim 37 complies with 35 U.S.C. §112**

Applicant’s Appeal Brief included significant detail regarding each of the above points. The Examiner’s responsive Answer offers only conclusory and unsupported statements with regards to Points I and III and fails to address Point II at all. Because the Answer fails to rebut the argument put forth in the Brief, the Board should grant Applicant’s request to withdraw the rejections of claims 32 and 35-38.

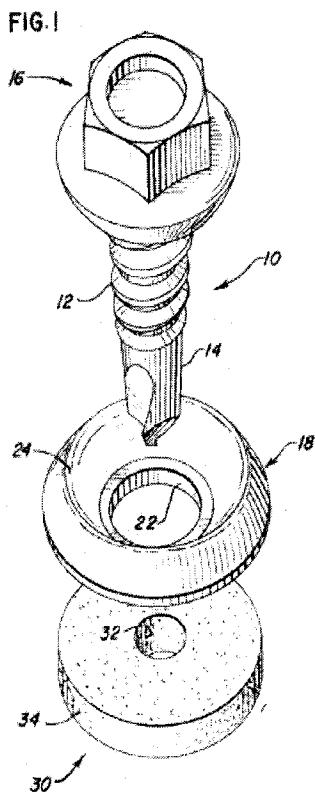
### **I. THE ANSWER FAILS TO REBUT ARGUMENTS THAT NO PRIMA FACIE CASE OF OBVIOUSNESS HAS BEEN MADE WITH REGARD TO THE OBVIOUSNESS REJECTIONS OF CLAIMS 32, 35 AND 36**

The Applicant’s Appeal Brief submitted that no prima facie case of obviousness has been put forth with regards to claims 32, 35 and 36. These claims stand rejected as obvious over the ‘465 patent in view of the ‘723 patent and in further view of the ‘185 patent. Claims 35 and 36 are independent, and claim 32 depends from claim 36. Each of claims 35 and 36 require at least four anti-rotation elements. The ‘723 and ‘465 patents are cited in combination to disclose these elements. Each of claims 32, 35 and 36 additionally require a resilient cover extending over the anti-rotation elements. The Office Action admits that the ‘723 and ‘465 patents fail to disclose these elements, but instead cites

the ‘185 patent for this. The Appeal Brief explained that relying on the ‘185 patent for this teaching is improper for several reasons. The Examiner’s Answer fails to address this on a substantive basis and instead only offers conclusory, unsupported statements which are largely irrelevant to the issues.

**I.A THE ANSWER’S ASSERTION THAT GUTSHALL DISCLOSES “A FASTENER HAVING A RESILIENT MEMBER MOLDED WITH AN ADHESIVE FOR PERMANENTLY BONDED” IS UNSUPPORTED AND IRRELEVANT.**

The Appeal Brief pointed out that the ‘185 patent does not teach or suggest a resilient cover as claimed by each of claims 32, 35 and 36 but instead teaches a very different seal washer, that the Examiner’s rejection is directed to elements that are not claimed, and therefore that no *prima facie* case of obviousness has been put forth. As explained in the Appeal Brief, the ‘185 patent fails to disclose the claimed resilient cover extending over anti-rotation elements as the final rejection alleges, but instead discloses a seal washer 30 which may be made of rubber or the like for use with a fastener such as a screw 12. Col. 5, lines 4-15; Col. 5, lines 26-35; Fig. 1:



As best understood, the subject invention of the '185 patent operates so that the seal washer 30 is deformed to seal any openings between the rigid washer and the fastener. Summary of the Invention. The seal washer 30 of the '185 patent therefore is not a "resilient cover" that extends over anti-rotation elements as claimed, but is instead a "seal washer" that has a different structure and that serves a very different purpose than the claimed resilient anti-rotation element cover.

In response to this argument, the Answer states on the top of page 8 that: "Nevertheless, Gutshall discloses a fastener having a resilient member and is molded with an adhesive for permanently bonded." (grammar errors in original). This statement is factually incorrect and further is irrelevant to the issues (as well as being somewhat unclear due to

grammar errors - the meaning of “for permanently bonded” is not certain). First, it is noted that whether or not Gutshall’s resilient member is “molded with an adhesive for permanently bonded” as the Answer alleges is not relevant since “molded with an adhesive for permanently bonded” (or any similar element) is not claimed by any of claim 32, 35 or 36.

Again, the claims recite:

- Claim 35: a resilient cover formed of a polymer extending over the anti-rotation elements, said resilient cover secured to said anti-rotation members by one of a chemical adhesive or thermoforming;
- Claim 36: a resilient cover for enhancing the adhesion of the mounting portion with the substrate;
- Claim 32: the resilient cover (of claim 36) is formed of a polymer and extends fully over said anti-rotation member, and is secured to said anti-rotation members by one of a chemical adhesive or thermoforming.

Further, putting aside the issue that the claims don’t recite a resilient cover that is “molded with an adhesive for permanently bonded” as the Answer alleges, it is additionally submitted that Gutshall fails to disclose such a structure. Notably, no section of Gutshall has been cited to support this allegation. As discussed above and more extensively in the Appeal Brief, Gutshall discloses a seal washer 30 (Fig. 1). No portion of Gutshall allegedly disclosing a cover secured by one of an adhesive or thermoforming (as claimed by claims 32 and 35) has been alleged or cited, much less a resilient cover secured to anti-rotation members with an adhesive or thermoforming.

**I.B THE ANSWER OFFERS NO MEANINGFUL RESPONSE REGARDING THE LACK OF MOTIVATION TO COMBINE THE ‘185 PATENT TEACHINGS WITH THOSE OF THE ‘723 AND ‘465 PATENTS**

The Appellant’s Brief also explained that (even accepting only for the sake of argument that the seal washer 30 of the ‘185 patent may be considered to satisfy the claimed elements of claims 32, 35 and 36) no prima facie case of obviousness has been made since there has been no objective evidence put forth showing that one considering any of the ‘465 or ‘723 patents would look to modify their teaching using the seal washer 30 of the ‘185 patent. The Answer offers only a cursory and conclusory response:

... the references to Logue ‘465, Jones ‘723, Farrell ‘458 and Gutshall ‘185 are presented in the above office action, and are properly rejected since they all have a close tie to a fastener connection. ... Furthermore, Farrell ‘458 fails to disclose a resilient member with adhesive means. Nevertheless, Gutshall discloses a fastener having a resilient member and is molded with an adhesive for permanently bonded. With the combination of the references listed above, appellant will see that the rejection are properly rejected with the motivation provided in the above office action.

(grammar errors in original) Last para., page 7 - first para., page 8. Accordingly, no meaningful response is provided regarding the lack of objective evidence to combine the cited references.

**II. THE ANSWER FAILS TO ADDRESS THE SHARP POINTED GRIPPER PRONGS OF THE ‘723 PATENT TEACHING AWAY FROM THE REQUIRED HEMISPHERICAL SHAPED ANTI-ROTATION ELEMENTS OF CLAIMS 37 AND 38.**

The Appellant’s Brief pointed out that the obviousness rejections of claims 37 and 38 are improper for still other reasons in addition to those discussed above. Claim 37 depends from claim 1 and claim 38 from independent claim 36. Each recite that the anti-rotation elements have a generally hemispherical shape. Both are rejected as obvious over the ‘723 patent in view of the ‘465 patent (claim 38 in further view of the ‘185 patent). The Final Action admits the claimed hemispherical shape anti-rotation element structure of these claims is not disclosed by the ‘723 patent, but suggests that it represents only an obvious variation in shape over the disclosure. Appellant’s Brief explained in detail that this is not correct, and that the ‘723 patent not only fails to teach these shapes but further teaches away from them since it teaches that sharp pointed gripper prongs are important to its intended purpose (Appeal Brief, Section II). The Examiner’s Answer fails to address this argument, and Applicant’s request that this rejection should be withdrawn should therefore be granted.

**III. THE ANSWER FAILS TO ESTABLISH THAT CLAIM 37 IS INDEFINITE**

Claim 37 has been rejected as indefinite under §112, second paragraph. Claim 1 recites that the anti-rotation elements have one of a generally hemispherical or a truncated cone shape. Claim 37 depends from claim 1 and recites that the elements have a generally hemispherical shape. For purposes of illustration, it may be considered that claim 1 recites that the anti-rotation elements have the shape of “one of a or b”; while claim 37 depending

therefrom recites that “the shape is a.” That is, claim 37 specifies which of the two alternative shapes of claim 1 applies. The Appellant’s Brief accordingly explained that claim 37 is definite and that this rejection was improper.

The Answer continues to argue that the indefiniteness rejection of claim 37 is proper, but fails to offer any sufficient reasoning. Page 8 of the Answer states: “Claim 37 contradicted with claim 1, since there are no drawings having both hemisphered or truncated cone shapes. Again, appellant will see that claim language in claim 1 and 37 do not go together and is not clear which shape appellant is trying to recite.” (grammar errors in original). The Examiner’s position is not clear. It is not understood, for instance, why a drawing showing both hemisphered and truncated cone shaped elements is necessary for claim 37 to be definite. It is once again submitted that claim 37 is definite and that the indefiniteness rejection should be withdrawn.

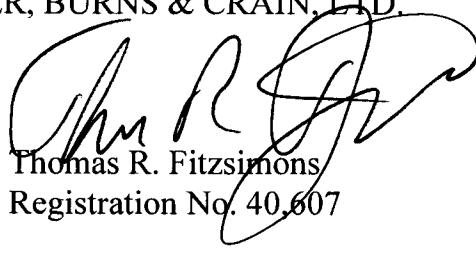
## **CONCLUSION**

The Answer offers only conclusory and unsupported responses to the positions explained in detail in the Appellant's Brief, and in some instances fails to respond whatsoever. Unfortunately, the Answer has thus continued the pattern of questionable and unsupported rejections that has occurred throughout the extensive prosecution of this application, which has now been pending for over six years and has proven quite costly for the Appellant. It is respectfully submitted that the Answer has failed to rebut the grounds for reversal of the rejections of claims 32, 35, 36, 37 and 38 set forth in detail in Appellant's Brief, and such reversal is called for.

Respectfully submitted,

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April 16, 2010

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